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EXAMINER

COLBERT, ELLA

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 08/863,047	Applicant(s) ITO ET AL.	
	Examiner Ella Colbert	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,9,10,12,13 and 17-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,9,10,12,13, and 17-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 4, 9, 10, 12, 13, and 17-46 are pending. Claims 1, 4, 9, 12, 17, 19, 23, 29, and 35-37 have been amended in this communication filed 10/01/08 entered as Amendment. The Request for RCE was filed and entered 10/30/08.

The claim Objections for claims 1, 9, 12, 17, 23, and 29 have been overcome by Applicants' amendment to the claims and are hereby withdrawn.

The 35 USC 112, First Paragraph Rejection for claims 1, 4, 9, 10, 12, 13, and 17-46 still remains as set forth here below.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/08 has been entered.

Claim Objections

Claims 1 and 9 are objected to because of the following informalities:
Claim 1 is in improper method claim format. A method claim to be in proper method claim format should be recited as follows: "identifying the at least one candidate folder in the search step, displaying the at least one candidate folder identified in said candidate folder search searching step;". Claim 9 has a similar problem.

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Claims 4, 10, 13, and 17-46 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The independent claims 1, 9, and 12 do not contain "a similarity between a feature of the new document and average features" or anything relating to "judging the similarity degree of a feature of a document or the average features of a plurality of documents". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 as amended recites "a processor that executes program code for a candidate search process ...". The Specification recites on page 7 "In figure 2, reference numeral 202 represents a CPU which operates in accordance with programs stored in a ROM 203. The next amended claim limitation recites "display means for in response to the candidate folder search process identifying the at least one candidate folder displaying ...;". The Specification on page 8 recites "... Fig. 3, the operation of a

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candidate folder search process of the document processing system ... “ The first amended claim limitation would be better written as “document storing system processor means for executing program code for a candidate folder search process ...; display means for identifying at least one candidate folder in response to the folder search process, displaying ...”. Claim 4 is rejected for the dependency from a rejected base claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 9, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: claim 1 omits the elements “display means for identifying at least one candidate folder in response to the candidate folder search process and displaying the at least one candidate folder; and storing means for storing the new document into a selected folder selected by a user in a candidate folder from among the plurality of folders.” Claims 9 and 12 have a similar problem. Claims 4, 10, 13, and 17-46 are also rejected for their dependency from a rejected claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claims 9 and 10. Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a “process” under 35 USC 101, a claimed process must either: be tied to another statutory class (such as a particular apparatus) or (transform underlying subject matter (such as an article of materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements are met by the claim, the method is not a patent eligible process under § 101, and is non-statutory subject matter. An example of a method claim that would not Qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In many instances it is clear within which of the enumerated categories a claimed invention falls. The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to - - process, machine, manufacture, or composition of matter -- but rather on the essential characteristics of the subject matter, in particular, its practical utility. In the instant invention, the claimed subject matter does not cover either a 101 judicial exception or a

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practical application of a 101 judicial exception. The claimed subject matter is merely directed towards an abstract idea. While a scientific truth, or mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge or scientific truth may be. *Diehr*, 450 U.S. at 188, 209 USPQ at 8-9. *Diehr*, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197; *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); *Benson*, 409 U.S. at 67-68, 175 USPQ at 675; *Funk*, 333 U.S. at 130, 76 USPQ at 281. “A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right”. *Le Roy*, 55 U.S. (14 How.) at 175.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 4, 9, 10, 12, 13, and 17-46 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 5,418,946) Mori.

Claims 1, 9, and 12. Mori discloses, A document storing system comprising: folder retainer means for retaining a plurality of folders, each of the folders storing at least one document (col. 4, lines 7-25); new document retainer means for retaining a new document (col. 4, lines 26-40); a processor that executes program code for a

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candidate folder search process for searching the plurality of folders to identify at least one candidate folder from the plurality of folders suitable for storing the new document, by comparing a feature of the new document with an average of features of the documents stored in at least one candidate folder among the plurality of folders, wherein the at least one candidate folder has documents more similar to the new document than other documents in the plurality of folders (col. 4, line 41-col. 5, line 20, col. 6, line 48-col. 7, line 27, Col. 14, line 66-col. 15, line 15, Fig. 13, and Fig. 18); display means for, in response to the candidate folder search process identifying the at least one candidate folder, displaying the at least one candidate folder identified by said candidate folder search process (Fig. 18-shows a candidate folder-company BB (1802) displayed in window (1700)) and storing means for storing the new document into a selected folder selected by a user from among the at least one candidate folder displayed by said display means (col. 9, lines 30-62).

Claims 4, 10, and 13. Mori discloses, wherein prior to the searching of a plurality of folders, the candidate folder search process judges a similarity degree representing a similarity between a feature of the new document and an average of features stored in each folder so that the judged similarity degree is used when a feature of the new document is compared with an average of features of the plurality of documents (col. 9, lines 11-62).

Claims 17, 23, and 29. Mori discloses, further comprising means for updating the feature the folder in response to saving of the new document in the candidate folder (col. 9, lines 30-46).

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Claims 18, 24, and 30. Mori discloses, wherein the document includes vector data (col. 7, line 67-col. 9, line 4) .

Claims 19, 25, and 31. Mori discloses, wherein the candidate folder has a high-level rank as determined by the result of the search by said folder searcher (Fig. 6 (601)).

Claims 20, 26, 32, 37, and 41. Mori discloses, wherein said notifying means displays a label which is set in advance to indicate the candidate folder (Fig. 6 (601)).

Claims 21, 27, 33, 38, 42, and 46. Mori discloses, wherein the document includes text data (Fig. 6 (606)).

Claims 22, 28, and 34. Mori discloses, further comprising means for causing the selected candidate folder to save the new document (Fig's 9 and 12)).

Claims 35 and 43. Mori discloses, further comprising notifying means for notifying a user of the at least one candidate folder by said folder searcher wherein said notifying means provides notification only of a predetermined number of folders which have a high rank of similarity order (Fig. 6-shows a predetermined number of folders with a high rank of similarity order).

Claims 36 and 44. Mori discloses, further comprising notifying means for notifying a user of the at least one candidate folder by said folder searcher wherein the document is stored in at least one folder mentioned in the notification provided by said notifying means (col. 9, line 66-col. 10, line 30).

Claims 37 and 41. Mori discloses, further comprising notifying means for notifying a user of the at least one candidate folder by said folder searcher wherein said notifying means displays a label set in advance to the selected folder (Fig's 6-9 and 12-19 shows

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a label that can be set in advance to the selected folder).

Claim 39. Mori discloses, further comprising the step of notifying a user of the at least one candidate folder in said searching step wherein the notification is provided only of a predetermined number of folders which have a high rank of similarity order (col. 13, line 44-col. 14, line 47 and Fig. 12 –shows company VF (AA) VF (1987) VF company (BB) VF (1987) and (1988) which are similar).

Claim 40. Mori discloses, further comprising the step of notifying a user of the at least one candidate folder searched in said searching step wherein the document is stored in at least one folder mentioned in the notification provided in said notifying step (col. 13, lines 20-28).

Claim 45. Mori discloses, further comprising the step of notifying a user of the at least one candidate folder searched in said searching step wherein said notifying step includes displaying a label set in advance to the selected folder (col. 13, line 29-col. 14, line 50)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Huffman (US 5,870,711) disclosed assigning folders to various workflow queues in order to process a cargo claim.

Vora et al (US 5,819,273) disclosed searching selected information.

Sakakibara (US 5,463,773) disclosed a decision tree and document classifying.

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Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

December 18, 2008